

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 21-36 are presently active in this case. Claims 1-20 have been canceled without prejudice or disclaimer, and Claims 21-36 have been added. The Applicant identifies Claims 21-23, 25-30, and 32-35 as being directed to the elected species of Figures 1-10. The Applicant notes that Claims 21, 22, 25-29, and 32-34 are generic to both species.

Care has been taken such that no new matter has been entered. Support for the amendments can be found in the drawings of the application and the corresponding description thereof in the specification. The claims have been reworded to clarify the widthwise, heightwise, and depthwise references made in the claims, and to clarify the previous recitations regarding “formed in a straight line,” which has been changed to indicate the uniform nature of such a feature that was intended by the previous language, as is evident from the drawings and description thereof. Additionally, the “bottom face” and “top face” references in the claims have been changed to “rear face” and “front face” in new Claim 32 for consistency with the other claims.

With regard to the issue of whether previously pending Claims 1 and 6 read on the elected species, the Applicant believes the phrase “formed in a straight line” was being misinterpreted in a way that Claims 1 and 6 did not appear to read on the elected species. More specifically, the phrase “the engaging groove being formed in a straight line” was being interpreted as the engaging groove having a straight line that extends in a depthwise direction, as in the top of groove (152) in Figure 11 but not in groove (152) in Figure 3, rather

than as an engaging groove that extends uniformly in a widthwise direction as is recited in new Claim 22, for example. The Applicant submits that the new claim language clarifies the interpretation of the claims, and thus it is submitted that Claims 21-23, 25-30, and 32-35 are directed to the elected species either generically or specifically.

The outstanding Official Action included a rejection under 35 U.S.C. 103(a) of previously pending Claims 14 and 15, which were rejected as being unpatentable over Ito (U.S. Patent No. 6,460,311) in view of Eaton (U.S. Patent No. 4,468,909). The Applicant submits that the newly added claims are not obvious in view of the combination of the Ito reference and the Eaton reference, for the reasons discussed below.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicant submits that a *prima facie* case of obviousness cannot be established in the present case because the references, either taken singularly or in combination, do not teach or suggest all of the claim limitations.

Independent Claims 21 and 25 recite, among other features, a front surface having vertical joint grooves extending in a heightwise direction of the siding board and partially extending within the siding board in a depthwise direction thereof, where the front surface is divided into plural areas by the vertical joint grooves such that the plural areas have different widths and heights. Independent Claim 32 recites, among other features, a front face having

vertical joint grooves extending in a heightwise direction of the siding board and partially extending within the siding board in a depthwise direction thereof, where the front face is divided into plural areas by the vertical joint grooves such that the plural areas have different widths and heights. The Applicant submits that the Ito reference and the Eaton reference, either taken singularly or in combination, do not teach or suggest all of the above claim limitations.

The Official Action noted that the Ito reference does not disclose a face having vertical joint grooves dividing the face into plural areas having different widths and heights, as is evident from a review of Figure 7 thereof. However, the Official Action cited the Eaton reference for such a teaching.

The Official Action cites tapered grooves or channels (66) of the Eaton reference for the teaching of the vertical grooves of the present invention. As is evident from a review of Figure 3, while the tapered grooves or channels (66) provide elements (54a) of varying widths along the widthwise direction of the panel, the elements (54a) are not provided with areas of different heights (see, e.g., lap 52 and lower edge 36), or even varying depths. The Official Action appears to suggest that the variation in the depth of the tapered grooves or channels (66) is being used for the teaching of the area of different height; however, while the tapered grooves or channels (66) may have tapered depths, the *areas (54a)* that they divide the face (54) into *each have the same height and the same depth*, as is evident from a review of Figures 3-7.

Accordingly, the Applicant submits that a *prima facie* case of obviousness cannot be established for independent Claims 21, 25, and 32 because the Ito reference and the Eaton

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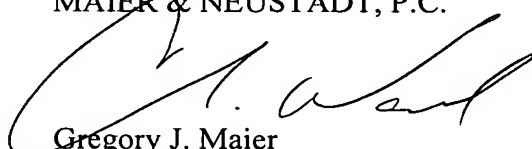
reference, either taken singularly or in combination, do not teach or suggest all of the claim limitations.

The dependent claims are considered allowable for the reasons advanced for the independent claim from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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